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KEVIN L. RUSSELL
CHERNOFF, VILHAUER, MCCLUNG & STENZEL LLP
1600 ODSTOWER
601 SW SECOND AVENUE
PORTLAND, OR 97204

EXAMINER	
CHOWDHURY, SUMAIYA A	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MUHAMMED IBRAHIM SEZAN, PETRUS VAN BEEK,
YOSHIAKI TOMIOKA, TADAHIDE SHIBAO,
and KOHEI YOSHIKAWA

Appeal 2009-004383
Application 09/544,808
Technology Center 2400

Decided: March 24, 2010

Before ROBERT E. NAPPI, JOSEPH F. RUGGIERO, and
THOMAS S. HAHN, *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) of the final rejection of claims 1-5 and 95.[1] We have jurisdiction under 35 U.S.C. § 6(b).

We affirm the Examiner's rejection of these claims.

INVENTION

The invention is directed to a method of managing audio, image, and video by setting user preferences. In addition, the method includes a protection attribute to protect information that is not intended to be public. *See* Spec. 1-2. Claim 1 is representative of the invention and reproduced below:

> 1. A method of using a system with at least one of audio, image, and a video comprising a plurality of frames comprising the steps of:
>
> (a) providing a usage preferences description, describing preferences of a user with respect to the use of said at least one audio, image, and video, where said description includes multiple preferences; and
>
> (b) providing a protection attribute with respect to a selected set of said preferences indicating whether the preferences in said selected set are considered public or private said protection attribute comprising a binary number having a number of bits equal to the number of preferences in said selected set and where each bit of said binary number indicates whether a particular preference in said selected set is to be public or private.

REFERENCES

Dedrick	US 5,696,965	Dec. 9, 1997

[1] Claims 6-94 were cancelled on July 16, 2004, in response to an Election/Restriction Requirement, mailed June 29, 2004.

O'Flaherty	US 6,253,203 B1	Jun. 26, 2001 (filed Oct. 2, 1998)

REJECTION AT ISSUE

Claims 1-5 and 95 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dedrick in view of O'Flaherty. Ans. 3-5.

ISSUE

Rejection of claims 1-5 and 95 under 35 U.S.C. § 103(a) as being unpatentable over Dedrick in view of O'Flaherty

Appellants argue on pages 4-7 of the Appeal Brief that the Examiner's rejection of claims 1-5 and 95 is in error. Appellants argue that neither reference teaches

> "providing a protection attribute with respect to a selected set of said preferences indicating whether the preferences in said selected set are considered public or private, said protection attribute comprising a binary number having a number of bits equal to the number of preferences in said selected set and where each bit of said binary number indicates whether a particular preference in said selected set is to be public or private."

App. Br. 4-5 (quoting claim 1).

Thus, Appellants' contentions with respect to claims 1-5 and 95 present us with the issue: Did the Examiner err in finding that Dedrick in view of O'Flaherty discloses providing a protection attribute with respect to a selected set of said preferences indicating whether the preferences in said selected set are considered public or private, said protection attribute comprising a binary number having a number of bits equal to the number of preferences in said selected set and where each bit of said binary number

indicates whether a particular preference in said selected set is to be public or private?

FINDINGS OF FACT

Dedrick

1. Dedrick discloses a system that automatically retrieves electronic information as a result of direct input and activity that is monitored by the system. Col. 1, ll. 37-40; col. 6, ll. 33-35.
2. Under particular circumstances, identifying information such as name and credit card information is provided to a publisher or advertiser. Col. 7, ll. 16-18.

O'Flaherty

3. O'Flaherty discloses a database management system that enforces privacy constraints. Col. 1, ll. 30-33.
4. A customer table is created that contains identity information, personal information, and sensitive information. Col. 7, ll. 5-7.
5. The consumer is able to control privacy preferences in regards to the consumer's data records. The five privacy preferences allow the consumer to "opt-out" from the following: "(1) direct marketing, (2) disclosure of personal data along with information identifying the consumer, (3) anonymous disclosure of personal data, (4) disclosure of personal data for purposes of making automated decisions, and (5) disclosure of sensitive data." Col. 7, ll. 15-24; Figs. 2A, 2B.
6. The consumer indicates which of the five privacy preferences he/she wishes to "opt-out" of through the use of a "0." If the consumer

wishes to "opt-in" for the particular privacy preference, the consumer indicates this by using a "1." Col. 7, ll. 15-24; Figs. 2A, 2B.

7. The data records each contain a "1" or "0" for each of the privacy preferences. Col. 7, ll. 15-24; Figs. 2A, 2B.

PRINCIPLES OF LAW

Office personnel must rely on Appellants' disclosure to properly determine the meaning of the terms used in the claims. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995) (en banc). "[I]nterpreting what is *meant* by a word *in* a claim is not to be confused with adding an extraneous limitation appearing in the specification, which is improper." *In re Cruciferous Sprout Litig.* 301 F.3d 1343, 1348 (Fed. Cir. 2002) (citations omitted) (internal quotation marks omitted).

On the issue of obviousness, the Supreme Court has stated that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007).

> [A]n implicit motivation to combine exists . . . when the "improvement" is technology-independent and the combination of references results in a product or process that is more desirable, for example because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient. Because the desire to enhance commercial opportunities by improving a product or process is universal . . . there exists in these situations a motivation to combine prior art references even absent any hint of suggestion in the references themselves. In such situations, the proper question is whether the ordinary artisan possesses knowledge and skills rendering him *capable* of combining the prior art references.

DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co., 464 F.3d 1356, 1368 (Fed. Cir. 2006).

ANALYSIS

Rejection of claims 1-5 and 95 under 35 U.S.C. § 103(a) as being unpatentable over Dedrick in view of O'Flaherty

Appellants' arguments have not persuaded us of error in the Examiner's rejection of claims 1-5 and 95. Claim 1 recites

> providing a protection attribute with respect to a selected set of said preferences indicating whether the preferences in said selected set are considered public or private said protection attribute comprising a binary number having a number of bits equal to the number of preferences in said selected set and where each bit of said binary number indicates whether a particular preference in said selected set is to be public or private.

Claims 2-5 and 95 depend upon claim 1, but were not argued separately. Therefore, claim 1 is selected to represent this group.

Appellants argue that neither reference teaches all of the limitations of claim 1 since O'Flaherty discloses five bits per preference rather than a protection attribute consisting of one bit per preference. App. Br. 5. We disagree. In order to meet the claim, the combination of Dedrick and O'Flaherty would have to disclose a five bit number wherein one bit is representative of each of the preferences. O'Flaherty discloses five different types of privacy preferences. FF 5. The privacy preferences include the ability to "opt-out" of the following: "(1) direct marketing, (2) disclosure of personal data along with information identifying the consumer, (3) anonymous disclosure of personal data, (4) disclosure of personal data for

purposes of making automated decisions, and (5) disclosure of sensitive data." FF 5.

O'Flaherty discloses the ability to "opt-out" or "opt-in" and disallow/allow the disclosure of private information as indicated by a "0" or a "1," respectively. FF 6. Each of the data records, therefore, contain a five digit binary number; one binary number for each of the five privacy preferences. FF 7. Thus, O'Flaherty does disclose a protection attribute comprising a number of bits equal to the number of preferences and Appellants' arguments are not found to be persuasive.

Appellants additionally argue that neither reference discloses the limitations of claim 1 since there is no motivation to combine Dedrick with O'Flaherty. App. Br. 5. Appellants argue that modifying Dedrick with O'Flaherty would make Dedrick's encryption key easy to crack and would be infeasible because of the unlimited amount of preferences. App. Br. 6. Lastly, Appellants argue that a protection attribute is not necessary if user-selected preferences are not included in a database. App. Br. 7. We disagree.

Initially we note that the Examiner concluded that it would have been obvious to combine the references in order to provide "the user with more control over the disclosure of his or her personal information to advertisers." Ans. 4. Appellants' statement merely concludes that this reasoning is in error without citing evidence or further explanation. App. Br. 5. We consider such a conclusory assertion without supporting explanation or analysis particularly pointing out errors in the Examiner's reasoning to fall short of persuasively rebutting the Examiner's prima facie case of obviousness. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Further, we agree with the Examiner that even if the encryption key would be easier to crack, this does not preclude someone from using it. Ans. 8. Even so, Appellants have merely speculated that the encryption key would in fact be easier to crack with the addition of a five bit binary number and have not supported the assertion with evidence. Appellants additional argument that it would be infeasible to combine the references since there is an unlimited amount of preferences is without merit as claim 1 does not preclude an unlimited amount of preferences.

Additionally, Dedrick discloses a system that automatically retrieves electronic information in accordance with user preferences that are observed by the system. FF 1. Under certain circumstances, personal information is provided to a publisher or advertiser. FF 2. O'Flaherty discloses a database management system that enforces privacy constraints on particular information through the use of consumer selected privacy preferences. FF 3, 5. Therefore, we consider using O'Flaherty's database privacy preferences with Dedrick's electronic retrieval system as nothing more than using a known device to perform its known function of protecting private information. As such, we find that the combination of Dedrick with O'Flaherty yields the predictable result of selectively providing private information as allowed by the consumer.

Third, Appellants' argument that a protection attribute would not be required since information can be left out of a database is not persuasive. Appellants argue that the database cited by the Examiner allows the consumer to choose information to be included in the database. Ans. 7. This is not the case. The database in O'Flaherty contains all of the personal information. FF 4. However, the consumer may choose one of or more of

the privacy settings for the consumer's data record. FF 5. These privacy settings control what information is disseminated and for what purpose. FF 5. Therefore, Appellants' arguments are not found to be persuasive.

Thus, for the reasons stated above, we sustain the Examiner's rejection of claim 1 and of claims 2-5 and 95, which are grouped with claim 1.

CONCLUSION

The Examiner did not err in finding that Dedrick in view of O'Flaherty discloses providing a protection attribute with respect to a selected set of said preferences indicating whether the preferences in said selected set are considered public or private, said protection attribute comprising a binary number having a number of bits equal to the number of preferences in said selected set and where each bit of said binary number indicates whether a particular preference in said selected set is to be public or private.

SUMMARY

The Examiner's decision to reject claims 1-5 and 95 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136 (a)(1)(iv).

AFFIRMED

babc

CHERNOFF, VILHAUER, MCCLUNG & STENZEL
601 SW SECOND AVENUE
SUITE 1600
PORTLAND, OREGON 97204-3157